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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/604,083

Applicant(s)
Bessette

Examiner
Michele Flood

Art Unit
1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 1, 2001
- 2a) This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above, claim(s) 7 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) ☒ approved b) ☐ disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) All b) Some* c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

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| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 18) Interview Summary (PTO-413) Paper No(s) |
| 16) Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) Notice of Informal Patent Application (PTO-152) |
| 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) | 20) Other |

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DETAILED ACTION

Election/Restriction

Applicant's election with traverse of Group I, Claims 1-6 in Paper No. 8 is acknowledged. The traversal is on the ground that the distinct inventions do not present a serious burden on the Patent Office to examine all of the claims. This is not found persuasive because the invention of Group I is drawn to pesticidal composition for the control of mites, whereas the invention of Group II is drawn to a method for controlling mites in stored food products. The groups are drawn to two different inventions. The inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for invention effect and require independent searches (as indicated by the different classification). The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Moreover, it is old and well-known in the art that the control of mites in stored food products can be practiced with a materially different product. For instance, Krenzer et al. (US Patent #3,720,684) teaches thiadiazoles which are used in a method for the control of mites in stored plant products.

The requirement is still deemed proper and is therefore made FINAL.

The claims have been examined, insofar, as they read on the elected invention.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 6 recite the limitation "the plant essential oil compounds or derivatives" in lines 1-2. There is insufficient antecedent basis for this limitation in the claims.

Claims 1-6 recite the limitation "derivative". One of ordinary skill in the art would not know how to interpret the metes and bounds of this limitation. A derivation of a chemical compound may be closely patterned after the subject chemical compound or may be loosely patterned after the subject chemical compound, such that it may bear no resemblance or form recognizable as the subject chemical compound which maybe chemically and/or biologically unrelated in function or form to the subject chemical compound.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by (N, JP 04059703) or (O, JP 04164072A).

Applicant claims a contact or fumigant pesticidal composition for the control of mites comprising, in admixture with an acceptable carrier, at least one plant essential oil compound or derivative thereof. Applicant further claims a composition, wherein the plant essential oil or derivative thereof, comprises a monocyclic, carbocyclic ring structure having six-members and substituted by at least one oxygenated or hydroxyl functional moiety. Applicant further claims a contact or fumigant pesticidal composition, wherein the plant essential compounds or derivative are selected from the group consisting of phenyl ethyl alcohol.

JP 04059703 teaches a miticidal composition comprising carvone, p- methyl acetophenone, 2-phenylethyl alcohol, (iso)thymol, methyl benzoate and/or methyl salicylate in the form of emulsions, dispersions, oil preparations, dusts, tablets or propellants.

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JP 04164072 teaches a miticide comprising an oxypyrimidine derivative, which was prepared by dissolving d,l-4-tert-butyl-alpha-phenylethylalcohol in N, -dimethylformamide and sodium hydride to obtain d,l,5-chloro-6-ethyl-1(1-4-tert-butylphenyl)ethoxy)pyrimidine.

JP 04059703 and JP 04164072 anticipate the claimed subject matter.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Zocchi et al. (A, US Patent 5,719,114) or Lover et al. (D).

The claimed invention was set forth above.

Zocchi (A, '114) teaches a detergent comprising essential plant oils (see Column 5, lines 25-41), which exhibit acaricidal activity. In Column 14, lines 12-66, Zocchi teaches plant essential oils used in the making of miticidal compositions. In Column 18, lines 25-60, Zocchi teaches a contact pesticidal for the control of mites comprising phenyl ethyl alcohol.

Lover teaches a contact composition for the control of mites, wherein the composition comprises 2-phenylethanol (see Column 4, lines 47-60), and an acceptable carrier.

The references of Zocchi and Lover anticipate the claimed subject matter.

Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Zocchi et al. (B, US Patent 5,985,814) or Zocchi et al. (C, US Patent 6,087,402) or Bessette et al. (E).

The claimed invention was set forth above.

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Zocchi (B, '814) teaches a miticidal, carpet-cleaning composition comprising plant essential oils as an acaricidal agent (see Column 6, lines 33-60), and an acceptable carrier. The referenced composition taught by Zocchi is in the form of a contact liquid or hydrocarbon propellant (see Column 4, lines 51-63). In Column 11, lines 35-67 to Column 12, lines 1-32, Zocchi teaches that the acaricidal agents comprise a monocyclic, carbocyclic ring structure having six-members and substituted by at least one oxygenated or hydroxyl functional moiety. See Claims 1-16.

Zocchi (C, '402) teaches a foam composition for killing dust mites comprising an acaricidal agent and water. The acaricidal agents taught by Zocchi are essential plant oils, such as phenyl ethyl alcohol. See Column 5, lines 6-17. See Claims 1-5.

Bessette teaches a pesticide comprising plant essential oils and an acceptable carrier, wherein the plant essential oil comprises a six member carbon ring and having substituted thereon at least one oxygenated functional group (see Column 3, lines 41-47). In Column 4, lines 10-15, Bessette teaches phenyl ethyl alcohol as a compound comprising the referenced composition, which is effective against mites (see Table 13 in Column 13, lines 35-43). The compositions taught by Bessette are in the form of a wettable powder, a waterproof dust, a shampoo, a gel, and an aerosol spray.

The references of Zocchi and Bessette anticipate the claimed subject matter.

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Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-6 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 13-15 of copending Application No. 09/604,158. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-15 of copending Application No.

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09/604,158. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to a pesticidal composition for the control of either mites or house dust mites comprising the same or essentially the same ingredients, namely, phenyl ethyl alcohol.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is (703) 308-9432. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196 or the Supervisory Patent Examiner, Michael Wityshyn whose telephone number is (703) 308-4743.

MCF

August 7, 2001



CHRISTOPHER R. TATE
PRIMARY EXAMINER